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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,287

Applicant(s)

MARSICO ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,15-45 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 21,22,38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,15-20,23-37,39,41-45 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

Applicant's election without traverse of Claims 1, 3-7, 15-45 and 50 filed on 9/18/2006 is acknowledged. Claims 2, 8-14, 46-49 have been canceled.

Claims 21, 22, 38 and 40 include limitations of non-elected and canceled claims. Accordingly, Claims 21, 22, 38 and 40 have been withdrawn from consideration.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 7, 14, 20, 23, 24, 26, 27, 29-33, 37, 39, 42, 42, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee et al. (US 6,449,474) in view of Murray et al. (US 6,654,452).

Mukherjee et al. (Mukherjee) teaches a computer implemented method and system for providing call interception, comprising:

Independent Claims.

Claims 1 and 26. Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a

communication initiator with whom communication is not desired (intercepting the call from a malicious caller) (a complaint registration application) (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law-enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Claim 20. Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (from a malicious caller) (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law-enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Also, Mukherjee does not specifically teach that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication.

However, Mukherjee teaches that it is difficult to track or intercept unwanted call initiators, which allows a malicious call initiators to allude monitoring agencies (C. 1, L. 64-67), which, in turn, suggests a repetitive character of said unwanted calls, including making repetitive calls using the same number, and been asked by disturbed subscribers of said numbers not to call again.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to further modify Mukherjee to include that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication, because it would advantageously allow to prevent unwanted calls from all type of unwanted callers, including those who was previously notified, and who was not.

Claim 50. Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator

with whom communication is not desired (from a malicious caller) (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law-enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Dependent Claims

Claim 4. See reasoning applied to claim 1.

Claim 6. Said method wherein said parameter is telephone number of the initiator (C. 5, L. 55).

Claim 7. Said method wherein said parameter is mobile telephone number of the initiator (C. 5, L. 55).

Claims 17-18, 23-24, 27 and 30. Providing communication in TCP/IP protocol environment indicates use of SIP protocol.

Claim 29. See reasoning applied to claim 26.

Claim 31. See reasoning applied to claim 1.

Claim 32. Said server is adapted to send said message to a law-enforcing agency (third party) (C. 6, L. 23-26).

Claim 33. Said server is adapted to send said message to a law-enforcing (government) agency (C. 6, L. 23-26).

Claim 37 and 41. Providing communication in TCP/IP protocol (C. 6, L. 23-26).

Claim 39. Providing communication in TCP/IP protocol (C. 6, L. 23-26).

Claim 42. See reasoning applied to claim 20.

Claim 44. See reasoning applied to claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Pinder et al. (US 6,701,160).

Dependent Claim.

Claim 3. Mukherjee teaches all the limitations of claim 3, except specifically teaching that said communication is a short message service message.

Pinder et al. (Pinder) teaches a method and system for locally blocking incoming selected calls, wherein said incoming calls are short message service messages (C. 1, L. 65 – C. 2, L.1).

It would have been obvious to one having ordinary skill in the art to modify Mukherjee to include that said communication is a short message service message, as disclosed in Pinder, because it would advantageously increase the application field of the system, thereby increase revenue.

Claims 5, 28, 34-36, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Chow (US 5,644,629).

Independent Claim.

Claim 45. Mukheree teaches said system including a computer-readable medium including instruction to execute a method, comprising: receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying

(extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (from a malicious caller) by performing a lookup in a table (C. 6, L. 1-5, 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law-enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Also, Mukherjee does not specifically teach that said compliant registration message is generated *upon detecting that a manual trigger has been generated by the user* communication terminal during said communication.

Chow teaches a computer-implemented method and a computer-readable medium having computer-readable instructions embedded therein for implementing said method for dealing with unwanted or harassing telephone calls, wherein, upon detecting that a preprogrammed button (manual trigger) has been engaged, the different treatment of the incoming calls is established (Fig. 2A; C. 2, L. 28-39; C. 5, L. 33-59).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to incorporate the functionality of Chow,

because it would advantageously allow to provide users with hardware and software configured to identify incoming calls and to react to such calls by routing the call ring signal as the owner determines, as specifically stated in Chow (C. 3, L. 30-32).

Dependent Claims.

Claim 5. Chow teaches that said communication is a facsimile message (C. 1, L. 20). The motivation to combine the references would be to advantageously increase the application field for the system, thereby increase revenue.

Claim 28. Chow teaches that said communication is a computer (Fig. 1A; item 6). The motivation to combine the references would be to advantageously increase the application field for the system, thereby increase revenue.

Claim 34. See reasoning applied to claim 45.

Claims 35 and 36. Chow computer is capable to incorporate a call blocking database of Mukherjee.

Claim 43. See reasoning applied to claim 45.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view Ardon (US 5,751,800).

Dependent Claims.

Claim 15. Murkherjee teaches all limitations of claim 15, except specifically teaching *in response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted.*

Ardon teaches a method and system for screening of incoming calls prior to call completion, wherein, upon receiving unwanted call, a message that this call are not accepted is send to the call initiator (C. 3, L. 15-19).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Murkherjee to include notifying the communication initiator that these calls are not accepted in response to receiving the call signaling message from the communication initiator, as disclosed in Ardon, because by warning

the call initiators of undesirability of his action, it would advantageously allow said caller to avoid possible future interaction with a law-enforcing agency.

Claim 16. Murkherjee and Ardon teach all the limitations of claim 16, including in response to receiving the call-signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted. (Ardon; C. 3, L. 15-19).

However, Murkherjee and Ardon do not specifically teach that notifying the communication initiator includes notifying that the complaint registration message is being sent to a complaint registration database.

Official notice is taken that it is well known to warn unwanted telemarketers (communication initiators) that further calls would result in a complaint to an appropriate authority. It is also well known that to pursue the legal action against unwanted contacts, one has to prove that the unwanted entity has been warned that said contacts are unwanted.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Murkherjee and Ardon to include notifying the communication initiator that the complaint registration message is being sent to a complaint registration database, because it would prevent the communication initiator from calling to the recipient again.

Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Almgren et al. (US 6,668,175).

Dependent Claims.

Claims 19 and 25. Mukherjee teaches all the limitations of claims 19 and 25, except specifically teaching that extracting parameter from the signaling message includes extracting a parameter *from the From field of the invite message*.

Almgren et al. (Almgren) teaches a method and system for providing rules-defined communication services, including blocking calls, using session initiation protocol, wherein the session is identified and characterized by means of the packet

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headers (encapsulating the message), from which various parameters, including identification data, can be extracted (C. 8, L. 12-25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mukherjee to include extracting identifying data from the invite message, as disclosed in Almgren, because it would advantageously allow to keep track of sources of incoming messages, thereby helping law enforcement agencies to identify most active suspects.

Response to Arguments

Applicant's arguments filed 9/18/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Mukherlee fails to teach or suggest hardware or software for determining whether a communication is from a communication initiator with whom the intended recipient does not desire to communicate, it is noted that Mukherlee specifically teaches dealing with malicious callers, resulting in a connection made to law enforcing agency. Under the "broadest reasonable interpretation" the examiner considers such calls made by said malicious callers as "unwanted" calls.

In response to applicant's argument that Mukherjee fails to teach or suggest automatically generating a forwarding and complaint registration message in response to determining that the communication is from a communication initiator with whom the intended recipient does not desire to communicate, it is noted that Mukherjee does, in fact, teach said feature (C. 6, L. 14-26). As per *complaint* registration message per se, so as the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message, it would have been obvious to conclude that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, since it would allow to

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catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

In response to applicant's argument that Mukherjee fails to teach or suggest determining whether the communication initiator has previously been notified not to initiate communications with the communication recipient, it is noted that Mukherjee teaches that it is difficult to track or intercept unwanted call initiators, which allows a malicious call initiators to allude monitoring agencies (C. 1, L. 64-67), which, in turn, suggests a repetitive character of said unwanted calls, including making repetitive calls using the same number, and been asked by disturbed subscribers of said numbers not to call again. Therefore, it would have been obvious to conclude that that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication, since it would prevent calls from all type of unwanted callers, including those who was previously notified, and who was not.

So as the remaining arguments essentially repeat the above-referenced arguments, reasoning applied to said above-referenced arguments are equally applicable to said remaining arguments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

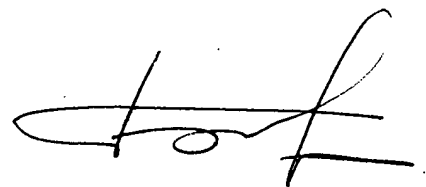
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
11/27/2006



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PRIMARY EXAMINER